REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested. Claims 1-9, 14-22, 25-34, 39-47 and 50-55, are in the case.

Status

In the Office Action of October 30, 2008, claims 1-54 were rejected under 35 U.S.C. § 101 for lack of statutory subject matter.

Claims 1-54 were further rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement.

Claims 1-54 were further rejected under 35 U.S.C. § 112, second paragraph for indefiniteness.

Claims 1-54 were further rejected under 35 U.S.C. § 103(a) for being obvious in light of US Publication No. 2004/0117451 A1 (Chung) in view of the publication "Mailcat: An Intelligent Assistant for Organizing E-mail" (Segal) and further in view of US Publication No. 2002/0040370 (Entwhistle).

Improper Final Rejection

The Examiner has made the Office Action of October 30, 2008 a Final Action. Applicant directs the Examiner's attention to MPEP § 706.07(a) (Final Rejection, When Proper on Second Action):

> Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on**

> **information submitted in an information disclosure statement**
> filed during the period set forth in 37 CFR 1.97(c) with the fee set
> forth in 37 CFR 1.17(p).

In particular, Applicant notes that the Examiner has introduced a new ground of rejection that is neither necessitated by Applicant's amendment of the claims, nor based on information submitted in an information disclosure statement. Specifically, the Examiner has introduced a new rejection under 35 U.S.C. § 101. Applicant's amendments consisted primarily of incorporating limitations of dependent claims into the main independent claims and clarifying terms objected to by the Examiner. Furthermore, a rejection under 35 U.S.C. § 101 does not depend upon prior art. It is submitted that nothing in Applicant's amendments or information disclosure statements induced this rejection; the Examiner could have made this rejection in the first Office Action, but did not. Relatedly, Applicant also directs the Examiner's attention to MPEP § 707.07(g) ("Piecemeal examination should be avoided as much as possible"). Accordingly, Applicant respectfully requests that the finality of the October 30, 2008 Office Action be withdrawn.

Claim Amendments

In response to the Examiner's various objections and rejections, independent claims 1, 22, 29, 47, 54 and 55 and dependent claims 7, 40 and 41 are currently amended to, variously, explicitly recite patentable subject matter, more clearly define the invention and to more clearly distinguish it over the art cited.

In response to the Examiner's indefiniteness arguments the independent claims and dependent claims 40 and 41 are currently amended to more clearly define a "user-selected associated folder".

In response to the Examiner's subject matter arguments, independent claims 1, 22, 29 and 47 are currently amended to recite "an electronic communication device" and to indicate functional relationships of the claim elements.

Amendments to specification

Paragraphs 7, 9, 11, 11.1, 11.2 and 11.3 have been amended as shown to conform to amended claims 1, 29, 54, 22, 47 and 55, respectively. Support for these amendments is described below with reference to the corresponding claim amendments.

35 U.S.C. § 101 – Subject Matter

In the office action, the Examiner has rejected claims 1 to 54 under 35 U.S.C. § 101 because they are geared toward software per se. The Examiner further argues that independent claims 1, 22, 29, 47, 54 and 55 lack the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. 101. Likewise, the Examiner argues that they are clearly not a series of steps or acts to form a process nor are they are a combination of chemical compounds to be a composition of matter and, as such, they fail to fall within a statutory category. Applicant notes that another of the Examiner's rejections (under 35 U.S.C. § 103) considers at least the storage module and communication module to be physical devices and not software. Specifically, that rejection considers the storage module to be a "data storage system" and the communication module to be a "recipient server".

In any event, independent claims 1, 22, 29 and 47 are currently amended to recite the limitation of "an electronic communication device" (i.e., a machine). Other limitations in the claims have also been amended to recite the relationship to the computer-readable medium. In particular, the limitations define the functional inter-relationships between the modules and the processor (see MPEP

§ 2106.01, sub-section I, paragraph 2). For example, "a folder pre-selection cache <u>on the electronic communication device</u>" and "a message comparison module <u>operating upon the folder pre-selection cache</u>". Support for the limitation of an "electronic communication device" may be found, for example, at paragraphs 20 and 34-37 of the specification. Applicant notes that, although the term "mobile communication device" is used in the description, paragraph 48 teaches that the invention is not limited to mobile communication devices, and that other devices with electronic mail communication capability may be used to implement the invention.

Regarding the phrase "operating upon the folder pre-selection cache", support for "a message comparison module operating upon the folder pre-selection cache" may be found, for example, at paragraph 25 of the description. Support for "a folder pre-selection module operating upon the folder pre-selection cache" may be found, for example, at paragraph 45. Support for "a user-interface means on the computing device" may be found, for example, at paragraphs 27 and 35. Finally, support for "a cache-updating means operating upon the folder pre-selection cache" may be found, for example, at paragraph 35 of the description.

Finally, Applicant notes that claims 54 and 55 as previously presented recite a computer program product comprising a recording medium and means recorded on the recording medium for configuring the computer to perform the steps of a method. Applicant directs the Examiner's attention to MPEP § 2106.01:

> [...] "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component [...]

> When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Steps of claims 54 and 55 comprise functional descriptions of software functions, such as "providing a folder pre-selection cache having n configurable entries, n being a predetermined positive integer greater than one, each configurable entry being configured to include an associated pre-selection criterion, derived from a message to distinguish the message, for matching with the current message, and an associated folder identification for identifying an associated folder in the plurality of folders". These are not abstract ideas, music, literary works or arrangements of data. Nor are the claims directed to a mere algorithm with no other applications. For instance, the steps recite the use of a cache, operations upon storage folders and messages. Accordingly, to the extent that there is an underlying algorithm, it has practical applications in other domains not involving electronic messages.

Accordingly, it is respectfully submitted that claims 54 and 55 are directed to "functional descriptive material" that is recorded on some computer-readable medium and therefore cover statutory subject matter.

35 U.S.C. § 112, first paragraph – Lack of Written Description

In the office action, the Examiner has rejected claims 1 to 54 for failing to comply with the written description requirement. In particular, the Examiner considers the phrase "derived from a message to distinguish the message" and "to distinguish the current message" to be new matter. This position is respectfully traversed.

The phrase "derived from a message" is explicitly disclosed at paragraphs 25-28 of the specification as originally filed. For example, at paragraph 25 the specification discloses "the hash code 58 will be a hash obtained by applying a hash function to the subject attribute 44 in the case of the subject cache 56 and will be **derived from** the sender attribute 46 in the case of entries in the sender cache 54" (Para. 19 and Fig. 5 disclose the sender attribute 46 is a part of the message 24). Further, at paragraph 28, "[...] this configurable entry is configured

so that its **hash code 58 or pre-selection criterion is derived from the message 24**". One of ordinary skill in the art would certainly be aware how a hashing function operates and that one of its uses is in conveniently distinguishing possibly variable-length text strings from each other. Accordingly, in the context of the specification, the concepts of "derived from a message to distinguish the message" or "to distinguish the current message" are implicitly and inherently supported by the specification (see MPEP § 2163).

For clarity, Applicant further notes that the phrase "hash code or pre-selection criterion" contains an inclusive disjunction (i.e., union) that suggests to the skilled person that pre-selection criteria "derived from the message" are the results of those functions in the class containing hash functions. That is, hash codes are a preferred subset of the class of pre-selection criteria contemplated, but not the only class that may be used. Accordingly, "pre-selection criterion" encompasses a hash code.

35 U.S.C. § 112, second paragraph – Indefiniteness

The Examiner objected to the phrase "derived from a message to distinguish the message" as vague and unclear. In particular, the Examiner considers that "pre-selection criterion" remains vague and unclear. Applicant refers the Examiner to the above discussion regarding the association between hash codes and pre-selection criteria. Furthermore, Applicant directs the Examiner to MPEP § 2173.02, paragraph 2:

> [...] definiteness of claim language must be analyzed, not in a vacuum, but in light of:
> a) the content of the particular application disclosure;
> b) the teachings of the prior art; and
> c) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

It is respectfully submitted that the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art, all make it clear that the pre-selection criterion is the result of a function applied to attributes of a message that derives some distinguishing value therefrom. In particular, the specification makes clear that the pre-selection criterion is generated by a class of functions containing hash functions, although not necessarily limited to hash functions. Accordingly, it is respectfully submitted that the term "pre-selection criterion, derived from a message to distinguish the message" is both definite and clear in the context of the specification, in light of the prior art and further in view of the claim interpretation that would be given by one of ordinary level of skill in the art at the time of the invention.

If the Examiner elects to maintain this rejection, Applicant respectfully requests that the Examiner provide explicit reasoning to support the rejection and further "suggest claim language to Applicant to improve the clarity or precision of the language used" (MPEP § 2173.02).

Regarding the phrase "each message in the up to in previous messages is allocated to an associated user-selected folder in the plurality of folders", the Examiner argues that this phrase is vague and unclear because "an associated user selected folder" is unclear. Accordingly, the phrase "an associated user selected folder" has been amended in the claims to recite "a user-selected associated folder" to more clearly indicate relation to the term "associated folder" defined elsewhere in the claim. It is respectfully submitted that based on this amendment, as well as the teachings of the specification, that this term will be clearly understood by one of ordinary skill in the art.

35 U.S.C. 103(a) – Obviousness

Regarding independent claims 1, 22, 29, 47, 54 and 55, the Examiner has rejected these claims under 35 U.S.C. 103(a) as being unpatentable over Chung (U.S. Publication No. 2004/0117451 A1), Segal ("Mailcat: an intelligent assistant for organizing email") and further in view of Entwhistle (U.S. Patent Publication No. 2002/0040370).

The Examiner argues that Chung teaches a system for preselecting a folder for a current message. In particular, the Examiner considers that Chung teaches "a folder pre-selection cache having n configurable entries, n being a predetermined positive integer greater than 1, each configurable entry being configurable to record an associated pre-selection criterion, derived from a message to distinguish the message, for matching with the current message and an associated folder identification for identifying an associated folder in the plurality of folders". This position is respectfully traversed.

The Examiner appears not to have considered Applicant's previous arguments regarding the teachings of Chung and Segal with respect to "a folder pre-selection cache having n configurable entries" (see page 28 of Response to Office Action of May 12, 2008). In particular, Applicant argued that neither Chung nor Segal disclose a folder pre-selection cache comprising up to n configurable entries. However, in the last paragraph on page 5 of the final Office Action, the Examiner has simply reiterated the rejection of claims 1, 22, 29, 47, 54 and 55 in view of Chung, apparently without considering Applicant's argument or providing any explanation.

Applicant refers the Examiner to MPEP § 707.07(f):

> In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner

must provide clear explanations of all actions taken by the examiner during prosecution of an application.

[…]

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

For greater certainty, Applicant reiterates that Chung does not teach a pre-selection cache at all. Chung simply teaches determining whether a message contains "predefined identifiers" (i.e., particular XML tags) and, if it does, interpreting the XML to file the message accordingly (Chung, paragraph [0158] to [0164]). To the extent that Chung does teach a filtering system based on predefined identifiers, it is static and pre-determined and not "configurable". There is no cache involved. Accordingly, it is respectfully submitted that Chung fails to disclose "a folder pre-selection cache having n configurable entries".

Given the above, Chung necessarily fails to disclose "a message comparison module for comparing a comparison criterion, derived from the current message to distinguish the current message, with the associated pre-selection criterion of at least one entry **in the folder pre-selection cache to determine a matching entry in the folder pre-selection cache**". Likewise, Chung fails to disclose "a folder pre-selection module, for pre-selecting the folder identified by the associated folder identification of the matching entry when the message comparison module determines the matching entry **in the folder pre-selection cache**".

Furthermore, the Examiner argues that Entwhistle teaches "the cache updating means is operable, for each message in the up to n messages, to update the folder preselection cache, by configuring the corresponding configurable entry in the folder pre-selection cache such that the associated pre-selection criterion is derived from the message, and the associated folder identification of the corresponding entry identifies an associated user-selected folder previously selected for the message". This position is also respectfully traversed.

Specifically, Entwhistle does not teach "the folder pre-selection cache includes a corresponding configurable entry for each message in the up to n messages". The Examiner cites paragraph [0022]-[0028] in support of this argument, but these paragraphs merely provide an example of "storage locations [...] split into a series of folders, each having an identified attribute within that storage location such as, in the case of the 'companies' storage location, 'retailers', 'financial' and 'government'" (Entwhistle, paragraph [0021]). In other words, the cited paragraphs disclose an ordinary, folder-based e-mail filing system. However, Entwhistle elsewhere discloses a correlation database, wherein information extracted from headers of e-mails in the storage folders may be stored (paragraph [0041]). The correlation database taught by Entwhistle appears to use statistical correlation, wherein statistically-significant keywords are determined to be used for correlating with incoming messages. As such, the correlation database would not have a "configurable entry for each message"; rather, it contains aggregate data. Thus, even if the "correlation database" is taken to be a "folder pre-selection cache", Entwhistle fails to disclose a "corresponding configurable entry for each message in the up to n messages". Accordingly, for the reasons set out above, it is respectfully submitted that independent claims 1, 22, 29, 47, 54 and 55 are novel and non-obvious in view of the known art. Similarly, it is submitted that pending dependent claims are similarly allowable at least by reason of dependence upon their respective base claims, and also for the additional features they recite.

In view of the foregoing, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

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